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251. As the CAFC stated in *In re Clement*, 131 F 3d. 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) at page 1164 of 45 USPQ2d:

"The second step [in determining if there has been a recapture] is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection (cites omitted)"[Emphasis Added]

A review of the prosecution history of the original patent, 5,416,980 establishes that the applicant, during the prosecution of the application resulting in the patent, never surrendered the right to claim the application heat and moisture without regard to the use of a steam generator as the source. A study of the application as originally filed established that there were 17 claims originally presented. Every one of them was directly or indirectly limited to there being steam or a steam box present to produce heat and moisture. In the Amendment of February 25, 1993 (Amendment A), while claim 1 was amended to more specifically define where in the apparatus the steam is applied and by what specific steam producing means, there was no attempt to broaden the claim to eliminate the limitation that the application of heat and moisture comes from steam. Likewise, in claim 8 which originally called for a steam box for applying steam to the web, in Amendment A there was a limitation added to claim 8 defining the mode of application and control of the steam box but there was no attempt to broaden claim 8 by eliminating any reference to the fact that the source of temperature and moisture was steam. Similarly, in claim 18, which was a new claim added by Amendment A, the claim from its inception called for applying steam to the paper web. This is likewise true of claim 22 which was also added by Amendment A. Thus, in Amendment A there was no attempt to broaden the claims by getting rid of the concept that steam was a necessary source of moisture and temperature nor was there any narrowing of these claims down to steam or steam box.

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This is likewise true in Amendment B dated September 15, 1993. There are amendments to claim 1 in Amendment B but they have nothing whatsoever to do with attempting to broaden the claim by eliminating any reference to steam as to a source of temperature and moisture and this is likewise true of claim 8, 12, 14, 18 and 22. While additional claim 23-29 were also added in Amendment B, none of them represents an effort by the applicant to broaden his claims to eliminate steam as the source of temperature and moisture nor to narrow the claims down to steam or steam box.

Turning now to Amendment C dated April 25, 1994, claim 1 was amended in Amendment C but there was no effort whatsoever to remove the limitation that steam was what was applied to the web to control its temperature and moisture content nor to add such limitation. As to this subject matter, claim 1 remained unchanged. Likewise, claim 8 was amended in Amendment C but the amendment related to controlling the application of steam, not to adding it or eliminating it. Claim 18 was also amended in Amendment C to specifically recite the surface of the web to which the steam was applied. There was no effort to add or eliminate the concept of using steam as the source of temperature and moisture. This is also true of claim 22 which calls for raising the temperature of the bottom side of the web by applying a sufficient amount of steam. New claim 30 was added in Amendment C and this had the same language concerning where steam was to be applied as in claim 22.

Finally, Amendment D was entered on October 26, 1994. This Amendment D only amended one claim, originally numbered claim 8, now patent claim 6. The claim was amended to define the position of the "steam box end" in the drying section, not to try to broaden the claim by eliminating any reference to steam or a steam box nor to narrow the claim to add steam or steam box.

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From the foregoing it will be seen that throughout the lengthy prosecution of the original patent, the applicant/patentee never once attempted to present a claim that was not limited to the use of steam as the medium by which the temperature and moisture was applied to the web. It was always steam. There is no amendment in this entire prosecution history which can be said to narrow a claim not originally limited to the use of steam to one calling for steam as the medium for the application of temperature and moisture to the web which would constitute a surrender of subject matter broader than the use of steam as such medium. Since the subject matter of the source of temperature and moisture by other than steam was never surrendered by narrowing any such claim, to the steam, subject matter of such medium is not subject to the concept of recapture.

Specifically, there is no surrender present in the original patent prosecution history which applicant could possibly be attempting to recapture by eliminating reference to steam in the claims added by this reissue. All the elimination of reference to steam has been done in applicant's reissue application to broaden the reissue which applicant has every right to do so long as such broadening does not constitute a recapture subject matter which applicant surrendered during the prosecution of the original patent. *In re Clement Id.*

In view of the foregoing, it is respectfully submitted that applicant has now fully complied with §112 in that all claimed subject matter is supported by the drawings, including Fig. 6, and that Fig. 6 includes no new matter, and further that the absence of any reference to steam in the newly added claims of this application does not constitute a recapture. In view of the foregoing reconsideration and allowance of all claims are respectfully requested.

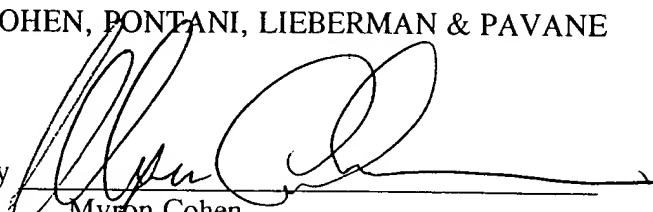
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It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By

A handwritten signature in black ink, appearing to read 'Myron Cohen', is written over a horizontal line.

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AMENDMENTS TO THE SPECIFICATION AND CLAIMS SHOWING CHANGES

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IN THE CLAIMS:

Please cancel claims 28 and 38, and amend claims 26, 34 and 39 as follows:

--26. A method of reducing the tendency of a paper web to curl in a paper machine, comprising the steps of:

asymmetrically drying the paper web in its thickness direction extending between the top and bottom sides of the paper web to a solids content at which curl-inducing stresses are formed in the paper web by passing the paper web through a plurality of top-felted single-tier normal dryer groups, each of said plurality of normal dryer groups including a single tier of dryer cylinders, a plurality of suction guide rolls disposed below and between said dryer cylinders, and a single wire transporting said web over the dryer cylinders and beneath the guide rolls so that only the bottom side of said web engages said dryer cylinders; and

subsequently applying sufficient heat and moisture to the asymmetrically dried paper web to relax said stresses in the fiber mesh of the paper web, to thereby control curling of the web.--

--34. A paper machine, comprising:

a dryer for asymmetrically drying a paper web in its thickness direction extending between the top and bottom sides of the paper web to a solids content at which curl-inducing stresses are formed in the paper web, said dryer including a plurality of top-felted single-tier normal dryer groups, each of said plurality of normal dryer groups including a single tier of dryer cylinders, a plurality of suction guide rolls disposed below and between said dryer

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cylinders, and a single wire transporting said web over the dryer cylinders and **beneath** the guide rolls so that only the bottom side of said web engages said dryer cylinders; and

a device for applying heat and moisture to the **asymmetrically dried** paper web for relaxing said stresses to thereby control curling of the web.--

--39. The paper machine of claim 34, wherein said stresses in said **fiber** mesh of the paper web are formed [or likely to be formed] at a solids content of at least about 70%.--